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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/726,961 | 12/03/2003 | Eric C. Erike | TRW(VSSIM)5875-1 | 4365 |
| 26294 7590 02/17/2010 TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P. 1300 EAST NINTH STREET, SUITE 1700 CLEVEVLAND, OH 44114 | | | | |
| EXAMINER | | | | |
| MCGUTHRY BANKS, TIMA MICHELE | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1793 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/726,961

Applicant(s)

ERIKE, ERIC C.

Examiner

TIMA M. MCGUTHRY-BANKS

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5, 7, 9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5, 7 and 10 is/are allowed.
- 6) ☒ Claim(s) 1, 3, 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

Claims 1 and 9 are currently amended, claims 2, 4, 6 and 8 are cancelled, Claim 3 is as originally filed, and Claims 5, 7 and 10 are as previously presented.

Terminal Disclaimer

The Terminal Disclaimers filed 10/26/06 and 1/22/07 disclaiming the terminal portion of any patent granted on this application that would extend beyond the expiration date of U.S.

Patent 6,386,583 has been reviewed and is NOT accepted.

The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because:

The person who has signed the disclaimer has not stated the extent of his/her interest, or the business entity's interest, in the application/patent. See 37 CFR 1.321(b) (3).

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim either is anticipated by, or would have been obvious over, the reference claim. See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3 and 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2 and 3 of U.S. Patent No. 6,386,583 (Erike '583) in view of Japanese Patent 410140283 (JP '283) alone or in view of the ASM Handbook.

Erike '583 discloses in Claim 2 a seamless tube of composition substantially the same as that in instant Claim 1. Regarding Claim 3, the tube tensile strength is recited of at least about 130,000 psi, yield strength at least about 104,000 psi and elongation at break of at least about 14% as in instant Claim 3. Regarding Claim 9, Erike '583 teaches a seamless tube. Erike '583 does not claim that the tube yields plastically more than about 5% before fracturing at temperatures down to about - 100 °C as in the amendment to instant Claim 1, nor does Erike '583 disclose that the tube is cold drawn induction-heated. JP '283 discloses a method of making a tube of the same or similar composition, which is substantially the same or similar to the method disclosed in the instant invention as discussed above regarding Claims 1, 3 and 9. JP '283 teaches that this provides a tube with high dimensional accuracy and excellent workability and is suitable for producing air bag parts requiring high strength and toughness (abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method of JP '283 to manufacture the steel disclosed in Erike '583 to produce a tube with high dimensional

accuracy and excellent workability suitable for producing air bag parts requiring high strength and toughness as taught by JP '283. Since the composition of the apparatus disclosed by Erike '583 is substantially the same as that of the instant invention, and the method of production disclosed by JP '283 is substantially the same as the claimed invention, and in the absence of evidence to the contrary, the tube produced by Erike '583 in view of JP '283 would be expected to have the same properties as the instant invention, including yielding plastically more than about 5% before fracturing at temperatures down to about- 100 °C.

Alternatively, JP '283 does not disclose induction-heating. The ASM Handbook is applied as discussed above regarding claim 1. Since the composition of the apparatus disclosed by Erike '583 is substantially the same as that of the instant invention, and the method of production disclosed by JP '283 in view of the ASM Handbook is substantially the same as the claimed invention, and in the absence of evidence to the contrary, the tube produced by Erike '583 in view of JP '283 and the ASM Handbook would be expected to have the same properties as the instant invention, including yielding plastically more than about 5% before fracturing at temperatures down to about - 100 °C.

Response to Arguments

Applicant's response is addressed above regarding the terminal disclaimers.

Allowable Subject Matter

Claims 5, 7 and 10 are allowed, as set forth in the office action mailed 10/20/2008.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIMA M. MCGUTHRY-BANKS whose telephone number is (571)272-2744. The examiner can normally be reached on M-F 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Wyszomierski/
Primary Examiner
Art Unit 1793

/T. M. M./
Examiner, Art Unit 1793
17 February 2010